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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,720

08/20/2003

Steven R. Mead

1-29092

8169

4859

7590

03/16/2011

MACMILLAN SOBANSKI & TODD, LLC  
ONE MARITIME PLAZA FIFTH FLOOR  
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TOLEDO, OH 43604-1619

EXAMINER

LAUX, JESSICA L

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/645,720	<b>Applicant(s)</b> MEAD, STEVEN R.	
	<b>Examiner</b> JESSICA LAUX	<b>Art Unit</b> 3635	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-32, 34-40 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-32, 34-40 and 42-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)             |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application   |
| Paper No(s)/Mail Date _____   | 6) <input checked="" type="checkbox"/> Other: <u>for references</u> |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/24/2011 has been entered.

### ***Specification***

The disclosure is objected to because of the following informalities: page 10, line 2 recites "thorough" which appears to be a typo that should correctly be "through".

Appropriate correction is required.

### ***Response to Arguments***

Applicant's arguments filed 2/24/2011 have been fully considered but they are not persuasive. In response to applicant's argument that Bainbridge is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Bainbridge is reasonably in the field of applicant's endeavor (the field of providing a foamed padded undersurface) and is reasonably pertinent to the particular problem with which applicant was concerned, namely a superior padding layer

Art Unit: 3635

(specifically of closed-cell foam material). Additionally it is noted that Bainbridge discloses that the foamed padding may be useful in any of various applications where foam padding is typically employed (Col. 9, lines 60-67), one of those applications being a flooring underlayment, thus demonstrating that it is indeed analogous; while Bainbridge does provide a listing of suitable uses, such listing is not presented as an exhaustive list, but merely a suggestive list of applications. It is well known and notoriously common to employ foam padding in a flooring installation, and therefore a flooring installation would be considered as a suitable use for foam and particularly the foam as disclosed by Bainbridge, thereby being both reasonably pertinent and within applicant's field of endeavor. Further US PG Publication 20040069924 and WO02055299 disclose that it is known to employ padding typically used in sports equipment (paragraph 0007; background of the invention, respectively) as an underlayment in flooring. Therefore in view of the disclosures of Bainbridge and 20040069924, WO02055299 one of ordinary skill in the art would have had good and sufficient reason and motivation to look to the disclosure of Bainbridge to solve the particular problem with which applicant was concerned, rendering indeed analogous. Lastly, Finley, 20040069924 and WO02055299 all disclose having a foam padding in flooring installations for providing properties such as: shock absorption, durability, energy dissipation, return upon contact, and porosity among others. Bainbridge and other foams used in sports equipment look to provide padding having similar characteristics and for that reason one of ordinary skill in the art would be motivated to look to Bainbridge for a foam padding.

Art Unit: 3635

Applicant's arguments that the problems addressed by Bainbridge are no the same problems as applicant is seeking to solve. However, that is not the test of analogous. Bainbridge discloses a product having particular features, including superior shock absorption, durability, energy dissipation, and porosity, which are features applicant is seeking. Whether Bainbridge is seeking to solves those features or not, Bainbridge does disclose a product having the features which applicant is seeking. Therefore, Bainbridge is analogous.

***. Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12, 19-32,34-38,42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finley (5578363) in view of Bainbridge (6453477).**

Regarding claims 1 and 19-20, 31-32, 45: Finley discloses a multi-layered flooring composite for use over a subfloor layer, said composite including a substantially horizontal top floor layer of substantially hard material (7), a subfloor layer of substantially hard material (6) and at least one acoustic layer (1) positioned between said top floor layer and said subfloor layer (where said layer includes a foam layer, abstract).

Finley does not expressly disclose the characteristics of the foam layer.

Bainbridge discloses a closed cell foamed material of Polypropylene, having a plurality

Art Unit: 3635

of discrete beads of substantially elastic, resilient material, wherein portions of adjacent beads abut one another and other portions of adjacent beads are spaced from each to create spaces therebetween that permit the flow of liquid through the acoustic layer, and wherein substantially all of said adjacent beads are integral joined together at the abutting portions thereof (Bainbridge - Col. 5).

It would have been obvious at the time the invention was made to modify the flooring and foam of Finley to be the foam material as disclosed by Bainbridge to provide a flooring surface that is resilient and durable for such activities as sports. (Reference US PG Publication 20040069924 and WO02055299 which teach using foams from sports padding in a flooring underlayment to make them suitable for cushioning and absorbing impacts due to sports while maintaining playability). Additionally it is noted that Bainbridge discloses In Col. 9, lines 60-67 using the padding material for use in other areas where padding is used (such as flooring).

Regarding claims 2-12, 22-23, and 35-38: The limitations of claims relating to the shape and location (including spaces) of the beads are merely limitations inherent to any of the various designs and constructions of a closed cell foam, as already known in the art and as disclosed by Bainbridge Cols. 2-5, 9.

Regarding claim 21: Finely in view of Bainbridge disclose the flooring composite as above, but do not expressly disclose the density of the acoustic layer, but do disclose various embodiments of fill percentages (equating to a density of the acoustic layer). It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the density of the acoustic layer to be between 2-10 pounds per cubic foot

Art Unit: 3635

as such a modification fails to provide an advantage, or solve a stated problem.

Furthermore one of ordinary skill in the art would be motivated to pursue known options (such as various densities) to achieve a desired result (such as a certain amount of acoustic absorption) for the intended purpose of the invention.

Regarding claims 24-26: Finley in view of Bainbridge disclose the flooring composite as above where the projected diameters are greater than 1/8 inch, the same, or 1/4 inch (Bainbridge - Col. 5, lines 1-15), but do not expressly that the thickness is 1/8 inch. However, applicant has not disclosed that the claimed thickness provides an advantage, solves a problem, or is for a particular purpose. Therefore it appears to be a mere matter of design choice to one of ordinary skill in the art to use a closed foam having the claimed thickness as one would expect applicant's invention and that of Finley in view of Bainbridge to perform the same function of sound attenuation equally well considering the properties of a closed foam. Therefor absent and criticality the claimed limitations are anticipated by the prior art.

Regarding claims 27-29, 42-44: Finley in view of Bainbridge disclose the claimed flooring composite as above, but do not expressly disclose the claimed percentages of beads and air spaces. However applicant has not disclosed that the claimed percentages provide and advantage or are for a particular purpose; furthermore the percentages appear to be obvious design choices for closed cell foams and one of ordinary skill in the art would be motivated to use any closed cell foam containing the various percentages as such a foam would provide the function of sound attenuation

Art Unit: 3635

equally well consider the properties of a closed cell foam and specifically that as disclosed by Bainbridge Cols. 2-5,9.

Regarding claims 30, 34: The flooring composite of claim 1, wherein said acoustic layer further includes a plurality of inelastic beads mixed with said elastic beads with portion of some of the elastic beads abutting portions of adjacent inelastic beads and being integrally joined thereto (Bainbridge – Col. 9, lines 45-50).

**Claims 13-16,39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finley (5578363) in view of Bainbridge (6453477) and further in view of Fiechtl (6189279).**

Regarding claims 13-16, 39-40: Finley in view of Bainbridge discloses the flooring composite as above, but does not disclose a moisture-proof film. Fiechtl discloses a floor system having a foam sound insulating layer and further including a moisture-proof film layer (18), where the layer is attached to at least some of the beads as it is attached to the foam comprised of the those beads.

The claimed limitations regarding the location of the film layer being between the acoustic layer and the subfloor or above the acoustic layer appear to be mere a mere design choice as applicant has not disclosed that either position provides an advantage, solves a stated problem or is used for a particular purpose, but rather discloses either position be an acceptable position. Therefore absent a showing of criticality, the limitations is anticipated by the prior art as disclosed above.

### ***Conclusion***



Art Unit: 3635

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jessica Laux/  
Examiner, Art Unit 3635